

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Thomas Peter John GARRETT *et al.*
Title: CRYSTAL STRUCTURE OF ERBB2 AND USES THEREOF
Appl. No.: 10/529,887
International
Filing Date: 10/06/2003
371(c) Date: 11/28/2005
Examiner: Hong Sang
Art Unit: 1643
Confirmation
Number: 7746

RESPONSE TO ELECTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to a species-election requirement set out in the Office Action mailed April 1, 2008, applicant elects what Examiner Sang has identified as the species of “CR1 domain dimerisation loop — i.e. ErbB2 amino acid residues 247—268, or a subset thereof.” Elected claims 63 and 64 read on this subject matter.

Applicant acknowledges, with thanks, the examiner’s statement that, “[u]pon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species with are written in dependent form or otherwise include all the limitations of an allowed generic claim.” By way of clarification, PTO rules call for the examination of “a reasonable number of species” *under* a “generic claim” that is found to be allowable as to an elected species. *See* MPEP § 806.04, citing 37 CFR § 1.146. Thus, there is no requirement for “claims ... written in dependent form,” etc., although applicant may well present such claims.

For a “Markush-type claim,” MPEP § 803.02 states that, “[i]f the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made

without serious burden, the examiner must examine all of the members of the Markush group . . . , even though they may be directed to independent and distinct inventions." For the presently elected, "Markush-type" claims, applicant would point out that the recited regions relate to the three-dimensional structure of the first three domains of ErbB2, which heterodimerizes with EGFR (and ErbB3 and ErbB4) to initiate signaling. In accordance with applicant's invention, dimer formation and, hence, signaling is blocked by an antibody that is keyed, so to speak, to a dimer interface constituted by the regions prescribed in the Markush group. For example, see paragraph 0024 and paragraphs 0184 and 0185 of the published application.

Accordingly, the members of the Markush group in question not only are few in number but also are closely related enough to permit ready search and examination of each elected claim, *in toto*. Pursuant to the PTO rules excerpted above, therefore, applicant respectfully submits that eventual examination of the "entire claim" is warranted and proper here.

The Commissioner is hereby authorized to charge any additional fees, which may be required under 37 CFR §§ 1.16-1.17, and to credit any overpayment to Deposit Account No. 19-0741. Should no proper payment accompany this response, then the Commissioner is authorized to charge the unpaid amount to the same deposit account.

Respectfully submitted,

Date 1 May 2006

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